UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. JEWELL
and
JULIE A. REIMER

Appeal No. 2006-1073
Application No. 10/228,815

ON BRIEF

Before KIMLIN, WARREN and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal from the final rejection of claims 1-7. Appellants have withdrawn the appeal of claims 14-17 (see page 1 of Reply Brief). Claim 1 is illustrative:

1. A cellulose fiber product resistant to biological degradation which comprises cellulose fibers derived from wood, the fibers initially being at least partially purified by a chemical pulping process, the product containing a biocidally effective amount of 0.1-2.0% by weight of dry fiber of a compound selected from the group consisting of didecyldimethylammonium

chloride, didecyldimethylammonium bromide, and mixtures thereof, the fiber product being resistant to fiber length degradation during refining.

The examiner relies upon the following references as evidence of obviousness:

Huth et al. (Huth)	5,049,383	Sep. 17, 1991
Nicholas et al. (Nicholas)	5,462,589	Oct. 31, 1995
Schultz et al. (Schultz)	5,730,907	Mar. 24, 1998
Holbek (Canadian '564) (Canadian Patent)	1,134,564	Nov. 2, 1982

Appellants' claimed invention is directed to a cellulose fiber product that is resistant to biological degradation and fiber length degradation during refining. The fiber product contains the recited amount of a compound selected from the group consisting of didecyldimethylammonium chloride (DDAC), didecyldimethylammonium bromide (DDAB), and mixtures thereof.

Appealed claims 1, 3, 4/1, 5/1, 6/1 and 7/1 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Canadian '564 in view of Huth or Schultz. Claims 2, 4/2, 5/2, 6/2 and 7/2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the stated combination of references further in view of Nicholas.

Upon thorough review of the opposing arguments presented by appellants and the examiner, it is clear to us that the present appeal is not ripe for decision.

Appellants set forth the following argument at page 7 of the principal brief:

> Such cellulose fibers have, in the past, been treated for fungal resistance with heavy metal biocides, such as copper sulfate, DDAC, or DDAB. Prior to introduction of fibers into the cementitious material utilized to make the fiber board, the cellulose fibers are subjected to a refining process, which is a mechanical process that singulates or separates the fibers from one another. It has been found, however, that cellulose fibers treated with what was heretofore considered to be biocidally effective amounts of, for example, copper sulfate, DDAC, or DDAB, have required significantly higher energy input for refining and are also subject to considerable degradation during the refining process. The appellants herein have found that the use of a relatively small amount of copper salt (from 0.01-0.25%) and/or DDAC, DDAB, or mixtures thereof (from 0.1-2.0%) is surprisingly still biocidally effective against fungi, while significantly reducing the refining energy required to singulate the fibers, and quite surprisingly, without significantly reducing the fiber length degradation of the fibers during refining.

Appellants rely upon Tables 5 and 6 of their published specification for demonstrating unexpected results attributed to using the claimed amount of the known biocides.

We have searched in vain for any discussion, let alone rebuttal, of appellants' specification data in the Examiner's

Answer. Accordingly, this application is remanded to the examiner for a complete analysis of the specification data relied upon by appellants for establishing unexpected results of the claimed subject matter. In so doing, the examiner should analyze the specification evidence and determine if the evidence of obviousness represented by the applied prior art, and admitted prior art, outweighs the evidence of nonobviousness cited by appellants. The examiner's determination should consider whether the specification data presents a comparison with the closest prior art, i.e., the admittedly known use of DDAB and DDAC as biocides for preserving wood, as well as the use of a copper salt as a biocide for wood disclosed by Canadian '564. Also, the examiner should determine whether the specification data is commensurate in scope with the degree of protection sought by the appealed claims, bearing in mind that claim 1 on appeal does not recite the presence of a copper salt. In addition, the examiner should evaluate whether the specification data would have been considered truly unexpected by one of ordinary skill in the art in light of the state of the prior art.

Accordingly, the application is remanded to the examiner for the reasons set forth above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMAND

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHUNG K. PAK Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CHARLES F. WARREN Administrative Patent Judge	)	

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Weyerhaeuser Company
Intellectual Property Dept., CH 1J27
P.O. Box 9777
Federal Way, WA 98063